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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,808	12/04/2006	Dimitri Philippou	130451.0103	7965
27557	7590	05/28/2010	EXAMINER	
BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			AFTERGUT, JEFF H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,808	Applicant(s) PHILIPPOU, DIMITRI	
	Examiner Jeff H. Aftergut	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,36,37,39-45,47-57,60-67 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34, 36, 37, 39-45, 47-57, 60-67, 72-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 101

because the disclosed invention is inoperative and therefore lacks utility for the same reasons as expressed in paragraph 1 of the Office action dated 10-1-09.

An invention that is “inoperative” (i.e., it does not operate to produce the results claimed by the patent applicant) is not a “useful” invention in the meaning of the patent law. See, e.g., *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) (“An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful.”).

Situations where an invention is found to be “inoperative” and therefore lacking in utility are rare, and rejections maintained solely on this ground by a Federal court even rarer. In many of these cases, the utility asserted by the applicant was thought to be “incredible in the light of the knowledge of the art or factually misleading” when initially considered by the Office. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). Other cases suggest that on initial evaluation, the Office considered the asserted utility to be inconsistent with known scientific principles or “speculative at best” as to whether attributes of the invention necessary to impart the asserted utility were actually present in the invention. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977).

However cast, the underlying finding by the court in these cases was that, based on the

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factual record of the case, it was clear that the invention could not and did not work as the inventor claimed it did. Indeed, the use of many labels to describe a single problem (e.g., a false assertion regarding utility) has led to some of the confusion that exists today with regard to a rejection based on the “utility” requirement. Examples of such cases include: an invention asserted to change the taste of food using a magnetic field (*Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985)), a perpetual motion machine (*Newman v. Quigg*, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989)), a flying machine operating on “flapping or flutter function” (*In re Houghton*, 433 F.2d 820, 167 USPQ 687 (CCPA 1970)), a “cold fusion” process for producing energy (*In re Swartz*, 232 F.3d 862, 56 USPQ2d 1703, (Fed. Cir. 2000)), a method for increasing the energy output of fossil fuels upon combustion through exposure to a magnetic field (*In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966)), uncharacterized compositions for curing a wide array of cancers (*In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963)), and a method of controlling the aging process (*In re Eltgroth*, 419 F.2d 918, 164 USPQ 221 (CCPA 1970)). These examples are fact specific and should not be applied as a per se rule. Thus, in view of the rare nature of such cases, Office personnel should not label an asserted utility “incredible,” “speculative” or otherwise unless it is clear that a rejection based on “lack of utility” is proper.

Applicant defines in broad terms a system of assembling via molecular and/or sub-atomic manufacturing of an object defined by signals from a transmission means which transmits the signals provided by at least one input means. There is no example provided in the disclosure as to how one could usefully make an object defined by

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signals, sub-atomic particles, atomic particles and impulses of energy which are transmitted via a transmission means from an input means. It simply is not deemed physically possible to manufacture an object from transmitted signals as defined. The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. Here the applicant is claiming an abstract idea to replicate matter and/or transport matter from one local to another which is just that, an abstract idea which is not entitled to patenting as it does not satisfy the requirements of being one of statutory subject matter.

It is clear that one cannot possibly assemble with at least one output means by at least one assembly means selected from the group comprising molecular, subatomic and impulses of energy which receive these elements from the transmission means and are capable of manufacturing an object from the molecular, sub-atomic, or impulses of energy. In other words, assembly of an object from impulses of energy, subatomic particles, and impulses of energy which are inputted and supplied to a transmission means is simply not physically possible in the manner described. It is that of science fiction which relates to replication from energy alone. The claimed invention lacks utility as the claimed process is not physically possible to perform.

It should be noted that claim 43 (which defines the locations to be different in “time periods”, “parallel worlds” and “time quadrants”) is clearly not possible.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As discussed above, the assembly system proposed by applicant simply is not capable of functioning in the manner described. One cannot make an object of matter from subatomic or atomic particles and/or impulses of energy which are inputted and transmitted from one local to another to make matter. There are no known ways in which matter can be created from energy. Additionally the manner of transmitting and inputting the atomic and subatomic particles is not described in any meaningful manner to make it so that one can make and/or use the invention in the manner described. There are simply no examples described in the disclosure which would have provided evidence that the claimed operation was physically possible. It should be noted that claim 43 (which defines the locations to be different in "time periods", "parallel worlds" and "time quadrants") is clearly not possible.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 70 and 72-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 70, the preamble of the claim has been amended to recite "A method for selling an object" while the body of the claim is solely limited to a method of making (manufacturing) the object. There is a total lack of nexus between the preamble of the claim and the body of the claim which does NOT relate in any way how the teleportation of an object from one location to another is a "sale" or "selling" of the object. As such the claim is NOT deemed to be clear and concise and clearly lacks some manipulative steps in the process therein to provide a nexus between the preamble of the claim and the body of the claim. Because the prior art (as discussed below) performed the manipulative steps as claimed, the prior art must include a method of selling an object as all of the selling steps claimed were performed by the prior art.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Sternbach et al (the portions from "Star Trek The Next Generation Technical Manual") for the same reasons as expressed in paragraph 6 of the Office action dated 10-1-09.

With respect to the method claims (and the method for "selling" an object), because the reference taught all the manipulative steps of the process, the reference

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must intrinsically provide a method for selling the object as there is no actual "sale" transaction recited in the claim. Since the reference suggested performing the identified manipulative steps it must perform the claimed method of selling an object as recited.

Response to Arguments

8. Applicant's arguments filed 4-1-10 have been fully considered but they are not persuasive.

The applicant is advised that it is not physically possible to convert energy into mass as claimed. There is no example defined in the specification of this "incredible" discovery. Applicant takes the position that those skilled in the art of would readily appreciate that the devices described in the specification inherently operate according to well known theories (e.g. Einstein's theories on quantum physics, such as quantum entanglement) is not well taken. One cannot obtain and/or show utility and provide operability of the device based solely on "theory". There must be some proof that the device and method actually work in the manner claimed.

As to the prior art rejection, the applicant did not address the teachings of Sternbach (there are no comments regarding the same by applicant). As such, it is deemed that applicant is in agreement with the Office interpretation of the reference. It should be noted that the replication and transporter described therein would have been understood to operate according to "well known theories (e.g. Einstein's theories on quantum physics, such as quantum entanglement) inasmuch as applicant's disclosure is enabled for the same and one skilled in the art would have readily understood how to

use the “theories of quantum entanglement” to practice the replication and transportation described by Sternbach.

No claims are allowed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:30-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff H. Aftergut/
Primary Examiner
Art Unit 1791

JHA
May 25, 2010